

Hara et al. clearly relates to providing a “*two-dimensional code capable of assuring excellent accuracy during the reading operation and providing excellent data ratio (ie. a ratio of a data area to the whole code area)*” (see column 2, lines 40 to 45).

Therefore, Hara et al. provides no pertinent solution to the nature of the problem stated above and does not obviously lead one of ordinary skill in the art to consider Hara et al in relation to the above mentioned problem.

Furthermore, there is no mention throughout the entire description of Hara et al that this form of two-dimensional code would be suitable for providing a camera with control instructions.

Additionally, a number of the Examiner’s reasons are clearly not considered valid reasons under US case law. Specifically, the Examiner has stated on page 4 of the Final Office Action:

“A CCD reader(500a) as taught by Hara et al. can be included at the interface (26, figure 2) of the electronic camera taught by Sarbadhikari et al. in order to read the two-dimensional code(Hara et al., column 15, lines 4 through column 16, line 42, see Figures 15 and 16). Furthermore, the camera control print medium(“memory card”,24, figure 2) taught by Sarbadhikari et al. can be replaced with an optically readable two-dimensional bar code(figures 9a and 9b) having computer control instructions printed thereon as taught by Hara et al.”

However, this is not a valid reasoning for a *prima facie* case of obviousness. As stated in *Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981):

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” (emphasis added)

The Examiner’s reasoning that particular elements, such as the CCD reader and the camera control print medium can be bodily included and replaced for different structures in the primary reference, are clearly invalid in light of the comments with relation to *Keller*.

The Applicant states that the combined teachings of Sarbadhikari et al in view of Hara et al. does not teach the claimed camera control print medium. Additionally, there is absolutely no suggestion of such inclusions or replacements in any of the citations, or in relation to the nature of the problem.

Moreover, the Applicant highlights that it is clear that Hara et al is not an analogous art. Hara et al is only concerned with coded data. There are no references to the coded data representing control instructions which cause a controllable image manipulator to perform at least one operation in relation to the at least one image manipulation print medium. Hara et al does not relate to the applicant’s field of endeavor due to failing to be relevant to a camera control print medium. Also Hara et al. is not pertinent to the problem which the inventor was concerned, that being providing an alternate form for control of the camera which utilises a printed medium.

The Applicant highlights MPEP 2141.01(a)I. which states:

"The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and State Contracting & Eng'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved)."

Additionally the Applicant highlights *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) which is discussed at MPEP 2141.01.(a).V. In *Wang Laboratories, Inc. v. Toshiba Corp.*, the Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories.

The decision in *Wang Laboratories, Inc. v. Toshiba Corp* is analogous to the current matter. Although Hara et al. discloses coded data, the Hara et al. is in a different field of endeavor because it relates to transfer of data via a CCD camera and not to transfer of control instructions to a digital camera.

The Applicant also highlights that Sarbadhikari et al teaches away from the claimed camera control print medium. In particular, Sarbadhikari et al states at column 2, lines 38 to 40:

"Such a method should be quick and convenient for the user, preferably without requiring the use of additional storage modules." (emphasis added)

It is clear based on the background section of the Sarbadhikari et al that one of the major problems being overcome is to have the image and control instructions to be stored on the same storage module.

However, the claimed camera control print medium is adapted for use with at least one image manipulation print medium. As stated in the last portion of claim 1, the camera control instruction is adapted, when so read, to cause the controllable image manipulator to perform at least one operation in relation to the at least one image manipulation print medium, when at least one image manipulation print medium is subsequently read by the print media reader.

Therefore, the claimed camera control print medium is for use with another print medium, that being the image manipulation print medium. This clearly leads away from Sarbadhikari et al as this document is concerned with eliminating the use of additional storage modules. The Applicant highlights MPEP 2141.02.VI which states:

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)"

In this instance, Sarbadhikari et al. is teaching the use of a single storage module which entirely contrasts to the claimed print medium which is for use with a second print medium, that being the image manipulation print medium.

Based on the above reasons, the Applicant respectfully request reconsideration and withdrawal of the claim rejection.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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